

REMARKS

I. Status of the Claims

Claims 80, 82, 83, 86-91, 97-100, 104-107, 112-115, 118-125, 135, and 139-186 are pending in this application. Claims 92, 93, 108-111, 116, 117, and 134 are canceled in this Amendment. Claims 83 and 150-166 are withdrawn from consideration. Claims 80, 82, 86-91, 97-100, 104-107, 112-115, 118-125, 135, 139-149, and 167-186 are currently under examination.

Claims 80, 116, 117, 185 are amended. The support for the amendments may be found in originally filed and now canceled claims 93, 109 and 111, and throughout the specification, for example, paragraph [030].

Applicants thank the Examiner for the telephonic discussion of January 10, 2012 with Applicants' representative Caroline Chen to clarify the status of the claims. As set forth in the Interview Summary, the Examiner clarified the claims that should be included in the two outstanding rejections. The statements of rejection below recite the rejected claims as indicated in the Interview Summary.

II. Double Patenting Rejection

As clarified during the telephonic interview, the Examiner maintains the rejection of claims 80, 82, 86-93, 97-100, 104-125, 134, 135, 139-149, and 167-186 on the ground of nonstatutory obviousness-type double patenting as "being unpatentable over claims 1-12, 15, and 18-99 of U.S. Application No. 10/603,698 ('698 Application). Office Action at 3. The Examiner asserts that "although the conflicting claims are not identical, they are not patently distinct from each other" *Id.* The '698 Application issued as U.S. Patent No. 7,777,348 ('348 Patent) on August 17, 2010. Solely to advance

prosecution of this application, Applicants file herewith a Terminal Disclaimer to the co-pending '698 Application ('348 Patent) to obviate the rejection. Applicants respectfully request that it be withdrawn.

III. Rejection under 35 U.S.C. § 103

As clarified during the telephonic interview, the Examiner maintains the rejection of claims 80, 82, 86-93, 97-100, 104-125, 134, 135, 139-149, and 167-186 under 35 U.S.C. § 103(a) as being unpatentable over Hanna et al. (U.S. Patent 5,843,417, "Hanna") in view of Bara et al. (U.S. Patent 5,902,592, "Bara"). Office Action at 5.

The Examiner states that Hanna discloses "a water-in-oil emulsion make-up composition comprising . . . (dyestuff) . . . 22% isododecane (volatile hydrocarbon based oil) . . . 4% propylene glycol (polyol comprising 3 carbons)," "propylene glycol . . . in amounts including 0.1-10%," and "can also further include volatile silicone oils in order to achieve a desired feel and behavior of the composition." *Id.* at 5-6 (emphasis added). The Examiner, however, concedes that Hanna does not teach "the specific volatile silicone oils as claimed by applicant," and "further lacks a second polyol comprising 4 to 6 carbons and being present in an amount of 1 to 7%," and cites Bara to cure these deficiencies. Office Action at 6. The Examiner asserts that Bara teaches "a cosmetic composition comprising 2-18% cyclopentadimethylsiloxane [sic] and 2-18% cyclohexadimethylsiloxane composition," and "[t]he preferred composition has an aqueous phase comprising 5% polyethylene glycol (4 carbon polyol) and 3% propylene glycol." *Id.* (emphasis added). Applicants respectfully disagree.

As an initial matter, Hanna does not teach or suggest the "at least one volatile hydrocarbon-based oil in an amount ranging from 8% to 15% by weight" as

required by independent claims 80 and 185 as amended. Rather, Hanna only discloses "isododecane (22 wt. %)" in the sole example. Hanna, col. 7, line 49.

In regards to Bara, independent claims 80 and 185 recite that the "second miscible polyol is chosen from butylene glycol, pentylene glycol, hexylene glycol, dipropylene glycol, diethylene glycol, and mixtures thereof." As acknowledged by the Examiner, Bara merely discloses polyethylene glycol in an example. This disclosure of polyethylene glycol would not teach or suggest the polyols now recited in independent claims. That is, Bara's disclosure of polyethylene glycol would not suggest the polyols chosen from butylene glycol, pentylene glycol, hexylene glycol, dipropylene glycol, diethylene glycol, and mixture thereof as required in instant claims 80 and 185 as amended.

Moreover, in view of the amendments to independent claims 80 and 185, a person having ordinary skill in the art would not be able to combine Hanna and Bara in an attempt to arrive at the composition in the claimed invention because neither of Hanna and Bara, collectively or individually, teach or suggest a "volatile hydrocarbon-based oil in an amount ranging from 8% to 15% by weight," and "a second water miscible polyol chosen from butylene glycol, pentylene glycol, hexylene glycol, dipropylene glycol, diethylene glycol, and mixtures thereof." The combined teachings of Hanna and Bara simply lack such teachings. Therefore, the instant claims are not obvious over the combined teachings of the prior art. Applicants respectfully request the Examiner withdraw the rejection.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

A handwritten signature in black ink, appearing to read 'M. Sweet', written over a horizontal line.

Dated: February 13, 2012

By: _____
Mark D. Sweet
Reg. No. 41,469